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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 10/517,588 | 12/09/2004 | Alexander Fuchs | LU 6021 (US) | 1330 |
| 34872 | 7590 | 07/24/2008 | | |
| Basell USA Inc. Delaware Corporate Center II 2 Righter Parkway, Suite #300 Wilmington, DE 19803 | | | EXAMINER NUTTER, NATHAN M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1796 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 07/24/2008 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/517,588 | Applicant(s) FUCHS ET AL. | |
| | Examiner Nathan M. Nutter | Art Unit 1796 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01-08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 June 2008 has been entered.

Response to Amendment

In response to the amendment filed 30 June 2008, the following is placed in effect.

The rejection of claims 17-20, 22 and 25-30 under 35 U.S.C. 102(b) as being clearly anticipated by Fischer et al (US 6,248,829), is hereby expressly withdrawn.

New grounds of rejection are being made.

In future correspondence, applicants are required to state support for each and every claim limitation added by amendment.

Further, applicants must, in the future, label "Amendments to the Claims," as such, and NOT as an Exhibit.

Failure to do either or both may result in the Response being deemed as Non-Responsive.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

MPEP §§ 2163.06 and 714.02 state that, when Applicant presents an amendment to the claims, "Applicant should specifically point out the support for any amendments made to the disclosure." Examiner has re-read the Specification, and it is unclear what elements therein correspond to the claimed "obtained from a two-stage or multistage polymerization process comprising a catalyst system comprising a metallocene compound, wherein the catalyst system is used in each polymerization stage," since the Specification does not utilize the statement "obtained from a two-stage or multistage polymerization process comprising a catalyst system comprising a metallocene compound, wherein the catalyst system is used in each polymerization stage."

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Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation of a “combination” of “extruding, (and) injection molding” is not shown by the Specification, as originally filed, at page 21 (lines 16-21) as applicants contend.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 17-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 and 9-15 of copending Application No. 10/517,580 (Fuchs et al US 2006/0167185). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims embrace the polymers and their compositional limitations as herein recited and claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer et al (US 6,248,829) as applied to claims 17-20, 22 and 25-30 above, and further in view of Mehta et al (US 6,583,227), newly cited.

The reference to Fisher et al teaches the manufacture of a propylene copolymer composition, comprising "a propylene copolymer containing from 1 to 20% by weight of olefins other than propylene and at least one propylene copolymer containing from 10 to 30% by weight of olefins other than propylene, where the propylene copolymer A and the propylene copolymer B are present as separate phases and a portion of n-hexane soluble material is \leq 2.6% by

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weight, and the propylene copolymer composition. Note the Abstract for the concept and compositional limitations, column 1 (lines 35-38 and 47-56) for products, column 2 (lines 30-51), column 3 (line 56) to column 4 (line 5), column 4 (line 38) to column 9 (line 67) for the identical catalyst employed, column 12 (lines 32-36), the many Examples and the claims, particularly claim 6, of the patent. The reference shows at the paragraph bridging column 11 to column 12 that the polymers may be produced separately and then mixed, and that they may both employ "the above described metallocene catalyst sytem," which would be tantamount to reactors in parallel (multi-stage).

The patent to Fischer et al does not teach the inclusion of a nucleant additive in the disclosed composition.

The reference to Mehta et al teaches at column 18 (lines 6-17) additives that are "commonly employed with plastics" including the polypropylene resins taught by the reference, include nucleants.

Subsequent use of a nucleant, as taught by Mehta et al, in the composition of Fischer et al for the benefits thereof would have been prima facie obvious to a skilled artisan.

Claims 17-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Datta et al (US 6,635,715).

The reference to Datta et al teaches the production of a reactor blend of a propylene copolymer blend that may comprise a propylene copolymer, designated as the First Polymer Component (FPC), having an alpha olefin

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content overlapping with that recited herein for the second copolymer at 10 to 30% by weight at column 5 (line 65) to column 6 (line 46), which alpha olefin may be ethylene, with the first recited copolymer, designated as the Second Polymer Component (SPC), having an alpha olefin content (ethylene) overlapping with that recited herein at 5 to 20% by weight at column 8 (lines 24-49). The range for inclusion of the two polymers is shown at the Abstract. The contemplated molecular weights and MWD are shown at column 9 (lines 34 et seq.). Note the Examples.

Although the reference is silent as regards the haze values, a skilled artisan producing an identical product would have a high expectation to achieve the same haze values recited herein. Likewise, the amount of extractables would be expected, or easily controlled, as crosslink density will determine soluble fractions and a skilled artisan would know to manipulate these values for desired end-use characteristics. As such, a skilled artisan would have a high level of expectation of success following the teachings of the reference to achieve the claimed inventions.

Response to Arguments

Applicant's arguments filed 30 June 2008 have been fully considered but they are not persuasive.

With regard to the rejection of claim 26 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, it is pointed out that the fact that extrusion molding is employed to make forms and

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injection molding is employed to make other types of objects (and specifically not continuous forms), the processes are not deemed to be co-extensive. A skilled artisan would recognize such and not be motivated to do both. Further, applicants have failed to show where in the Specification such concept is disclosed.

With regard to the provisional rejection of claims 17-30 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 and 9-15 of copending Application No. 10/517,580 (Fuchs et al US 2006/0167185), no Terminal Disclaimer has been filed.

With regard to the rejection of claims 17-27 under 35 U.S.C. 103(a) as being unpatentable over Datta et al (US 6,635,715), the process taught therein would embrace multi-stage concept since the polypropylenes may be produced separately. Applicants have failed to show any difference between the reactor blend they argue they have claimed. A closer reading of the claims does NOT provide specifically for a reactor blend, as purported.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1796

nmn

18 July 2008